



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,708	12/17/1999	FUMIKO SEMBA	FUJI-16.863	9208

26304 7590 06/18/2003

KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 06/18/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/465,708

Applicant(s)

SEMBA ET AL.

Examiner

Rasha S AL-Aubaidi

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10-361579.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action

Claim Objections

2. Claim 12 is objected to because "and", on line 2, should be moved to the end of line 4. Also, "of pushing", on line 6, should be --or pushing--.

Also, claims 11 and 12 are identical (except for the above-mentioned typographical errors in claim 12).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 9, 10 and 4 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Farris et al (US Patent 6,574,216).

Independent claims 9 and 10 have been amended to recite that the "call via the Internet" is a **"telephone call via the internet"** [Emphasis added]. Further, applicant now argues (page 5 of the amendment filed 5/28/03) that the switching of the **telephone call** in progress and currently connected via the Internet to another non-internet network is carried out for **improved voice quality**¹.

Claims 9 and 10 are clearly anticipated by Farris, which specifically teaches the switching of the telephone call in progress, and currently connected via the Internet (50, Fig. 3) to another non-internet network (PSTN 10, Fig. 3) in order to **improve voice quality**. See abstract, col. 9, lines 35-58 and col. 11, lines 22-58. The claimed "exchange" reads on SSP 13 or on the combination of SSP 13 and Internet module 92. All the claimed "parts" are in Farris because it performs all the claimed limitations. Pressing the "*" digit on the caller's telephone 11 during an economical Internet call will switch the call from Internet 50 to the PSTN 10 to improve the voice quality. The Internet may be selected when the caller dials a code such as *82 or based on the caller's routing criteria in his/her CPR (col. 9, lines 35-58)

¹ It is noted that the claims do not recite any limitation related to voice quality.

For claim 4, the reference teaches that using the service "would be economical, especially for long distance calls, compared with the toll rates charged by long distance interexchange carriers" (col. 1, lines 35-42) and teaches the use of CPR (col. 11, lines 28 and 48) for routing the calls. This reads on the claimed "least cost routing".

Claim Rejections - 35 USC § 103

5. Claims 9,10, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris.

Farris, as discussed above, may differ from the claims in that the Internet module 92, which performs some of the claimed limitation, is not exactly in SSP 13 ("switch"). However, including the module (means, and function) ⁱⁿ ~~is~~ SSP 13 would have been obvious and does not rise to the level of patentability. It has been held that separation or integration of components does not rise to the level of patentability.

6. Claims 11 and 12 (which are identical) are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogart in view of Wood or Leipow.

The rejection in the previous office action is hereby incorporated by reference. Note that claimed "call via the Internet" reads on chatting over the Internet as taught by Leipow and browsing the Internet as taught by Wood. Claims 9 and 10 have been amended to recite that the "call via the Internet" is a **-telephone call-**, however, claims 11 and 12 still broadly recite a "call via the Internet".

Response to Arguments

7. Applicant's arguments filed 5/28/03 have been fully considered but they are not persuasive. The arguments have been addressed above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (703)

Art Unit: 2642

605-5145. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Examiner

Rasha S. al-Aubaidi

06/09/2003


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700